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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte J. AARON BLY,
JOHN M. MELBY,
and RYAN J. SHERMAN

Appeal 2009-006568
Application 09/995,287¹
Technology Center 3600

Decided: November 16, 2009

Before LEE E. BARRETT, LANCE LEONARD BARRY, and
STEPHEN C. SIU, *Administrative Patent Judges*.

BARRETT, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) from the final rejection of claims 36-62. We have jurisdiction under 35 U.S.C. § 6(b).

We dismiss the appeal as to claims 36-45 and affirm-in-part the rejection of the remaining claims.

¹ Filed November 26, 2001, titled "System and Method for Tracking User Certification and Training."

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DISMISSAL-IN-PART FOR FAILURE TO RESPOND TO
NEW GROUND OF REJECTION

Appellants filed an Appeal Brief received October 3, 2006, appealing from a Final Office Action entered March 29, 2006. The Examiner entered a first Examiner's Answer on December 20, 2006. The appeal was docketed as Appeal 2007-3167 on June 26, 2007.

The assignee of the entire interest, Dana Holding Corporation, filed a paper received August 14, 2008, revoking the previous power of attorney and giving Power of Attorney to the Practitioner associated with Customer Number 27210, which is MacMillan, Sobanski & Todd, LLC, One Maritime Plaza - Fifth Floor, 720 Water Street, Toledo, OH 43604.

A Notice Regarding Power of Attorney was entered August 26, 2008, stating that the Power of Attorney is not accepted because "[t]he Power of Attorney is from an assignee and the Certificate required by 37 CFR 3.73(b) has not been received."

On December 1, 2008, the Chief Appeals Administrator entered an Order Remanding Appeal to Examiner based on a request from the Office of the Group Director of Technology Center 3600.

The Examiner entered a second Examiner's Answer (2d Ans.) on December 9, 2008, with a new ground of rejection of method claims 36-45 under 35 U.S.C. § 101. The Examiner's Answer notified Appellants that they had two months to respond to avoid *sua sponte* dismissal of the appeal as to the claims subject to the new ground of rejection. 2d Ans. 23.

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No response was received from Appellants and the application was re-docketed as Appeal 2009-6568 on April 3, 2009.

Because no response has been received in response to the new ground of rejection, the appeal as to claims 36-45 is dismissed. *See* 37 C.F.R. § 41.39(b). We do not address the other rejections of these claims.

STATEMENT OF THE CASE

The invention

The invention relates to methods and systems for utilizing wireless communications for performing inspection of an asset. The asset may be a piece of equipment, such as a forklift 31 in Figure 3. The Specification describes:

In a preferred embodiment of the invention, an electronic checklist 154 is completed by the asset operator on a regular basis, which may include information concerning asset performance that is more detailed than that available from a review of raw operational parameters. In accordance with OSHA requirements, for example, at the end of each shift, a forklift operator must complete a checklist concerning the performance of the asset during the shift. Some of the questions associated with checklist 154 are directed to maintenance issues. Therefore, in a preferred embodiment of the invention, checklist 154 would be completed electronically at the asset 31, and transmitted by way of the data acquisition device 32 to analysis controller 51 as discussed above. The information would be analyzed to determine if an OSHA/repair need is identified. Preferably, the analysis is automated in accordance with a comparison of the operational status with pre-determined rules. For example, if a question asks if there is a hydraulic leak for a forklift and the answer is "yes", then maintenance would be appropriate.

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Spec. ¶ [0079]. The operator of the asset provides authentication information as shown in Figure 9.

The claims

Claim 46 is reproduced below:

46. A wireless device for performing inspection of an asset utilizing a wireless communications system having a wireless infrastructure, said wireless device being associated with the asset and comprising:

an input unit operable to receive an operator identifier from an operator of the asset;

a processing unit operable to receive the operator identifier from said input unit and operable to prompt, independent of an active communication link between the wireless device and wireless infrastructure, a question related to operational status of the asset for the operator;

a display unit coupled to said processing unit and operable to display the question being prompted to the operator, a response to the question being prompted being received by said processing unit; and

a storage unit in communication with said processing unit and operable to store the response to the question.

The references

Hoehn-Saric	5,915,973	Jun. 29, 1999
Swor	6,148,297	Nov. 14, 2000

The rejections

Claims 36-62 stand rejected under 35 U.S.C. § 112, second paragraph, as indefinite.

Claims 36-62 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Swor and Hoehn-Saric.

DISCUSSION

35 U.S.C. § 112, second paragraph

In order to comply with the definiteness requirement of 35 U.S.C. § 112, second paragraph, a claim must reasonably apprise those of skill in the art of its scope. *In re Warmerdam*, 33 F.3d 1354, 1361 (Fed. Cir. 1994).

1.

The Examiner concludes that claim 36 is indefinite because the preamble recites a method "utilizing a wireless communication system having a wireless infrastructure and a wireless device," but the limitations of "prompting, independent of an active communication link between the wireless infrastructure and the wireless device" does not require utilizing the wireless communication system as the action is performed. Final Rej. 6. Claims 46 and 55 are rejected because they recite similar language. *Id.*

Appellants argue that the rejection does not provide any guidance as to why the plain language of the claim is not understood and therefore it should be reversed. Br. 15. It is argued that claim 36 clearly states that the step of "prompting" is plainly claimed as "independent of an active communication link between the wireless device and wireless infrastructure"

and is described in part as comprising "a question related to operational status of the asset for the operator," so the limitation is clear and definite.

Initially, we consider claim 46 because the appeal has been dismissed as to claim 36. We understand the Examiner's concern to be that "operable to prompt, independent of an active communication link between the wireless device and wireless infrastructure" in claim 46 does not require prompting "utilizing a wireless communications system having a wireless infrastructure" as recited in the preamble. Actually, none of the elements in the body of claim 46 require utilizing a wireless communications system. Nevertheless, we conclude that claim 46 is not indefinite just because no limitations have yet been recited that require a wireless communications system as in, for example, dependent claims 47 and 48. The preamble of claim 46 sets out the environment which is later limited to utilizing the wireless communications system. Claim 55 is similar. The rejection of claims 46-62 on this basis is reversed.

2.

Although the 2d Examiner's Answer repeats the rejection of claim 39 (2d Ans. 8), the Answer later states that the rejection of claim 39 is withdrawn. 2d Ans. 12. We treat the rejection as withdrawn. In any case, the rejection is moot because the appeal is dismissed as to claim 39.

3.

Claim 43 recites "determining if the question is required to be prompted." The Examiner notes that claim 36, from which claim 43 depends, specifies prompting a question to a user and concludes that

claim 43 is indefinite because "according to the language of claim 36, it has already been determined that the operator has answered in the affirmative regarding 'prompting.'" Final Rej. 7. Claims 44, 52, 53, 61, and 62 are also rejected as reciting similar language to claim 43. *Id.*

Appellants argue:

Once again, the Examiner's rejection lacks clarity, and should be reversed as [sic] least on that basis alone. Further, claim 43 clearly depends on claim 36, and clearly limits the conditions under which the "prompting of the question" may occur.

Br. 16-17.

The appeal has been dismissed as to claims 36, 43, and 44. Nevertheless, it is helpful to compare method claims 43 and 44 with apparatus claims 52, 53, 61, and 62. Independent claim 36 recites a positive step of "prompting . . . a question," whereas dependent claim 43 recites "determining if the question is required to be prompted" and dependent claim 44 recites "determining if the question is required to be prompted based on an operating condition of the asset," which seems to say that the step may not occur, thus contradicting claim 36. This is indefinite.

Independent claim 46 recites "a processing unit . . . operable to prompt . . . a question related to operational status of the asset for the operator"; i.e., structure capable of operating to prompt. Dependent claim 52 recites that the processing unit is further operable to "determine if the question is required to be prompted for the operator." Dependent claim 53 recites that the processing unit is further operable to "determine if the question is required to be prompted based on an operating condition of

the asset." Claims 52 and 53 specify the conditions under which the prompt may occur in the structure. This is different from the situation of method claim 36 which recites a positive step of prompting and then the dependent claims 43 and 44 stating that the prompt may not happen. We conclude that claims 52 and 53 are not indefinite. Similarly, claim 55 is directed to "means for prompting" and does not require a positive step of prompting. Thus, claims 61 and 62 which specify conditions on prompting are not indefinite. The rejection of claims 52, 53, 61, and 62 is reversed.

Objections. The Board ordinarily does not have jurisdiction to decide objections. Nevertheless, where the rejection and objection are related, the Board may consider it. *Cf. Manual of Patent Examining Procedure* § 608.04(c) ("Where the new matter is confined to amendments to the specification, review of the examiner's requirement for cancelation is by way of petition. But where the alleged new matter is introduced into or affects the claims, thus necessitating their rejection on this ground, the question becomes an appealable one, and should not be considered on petition even though that new matter has been introduced into the specification also."). We agree with the Examiner that claims 43 and 44 are properly objected to as not further limiting independent claim 36 because they purport to modify the positive limitation of "prompting." However, the objection to claims 52, 53, 61, and 62 is not correct since independent claims 46 and 55 only require structure "operable to prompt" and claims 52, 53, 61, and 62 specify the conditions when a prompt will occur.

35 U.S.C. § 103(a)

As previously noted, the appeal as to claims 36-45 is dismissed. We consider the rejection of claims 46-62 and translate Appellants' arguments regarding claim 36 into the language of representative claim 46.

Claims 36, 43, 44, 46, 52, 53, 55, 61, and 62

Contentions

The Examiner finds that Swor teaches a worker certification system comprising receiving a response and storing a response to a question (col. 5, ll. 33-45) utilizing a wireless communication system (col. 4, ll. 45-52), but does "not specifically disclose receiving an identifier from a test taker." Final Rej. 8. The Examiner finds that Hoehn-Saric teaches a test taking system where the system receives an identifier from a test taker (col. 8, ll. 23-29) and prompting a question independent of an active communication link as the questions are downloaded to and stored by the test taking device (col. 8, ll. 52-56). Final Rej. 8. The Examiner concludes that "it would have been obvious to one of ordinary skill to combine the teachings of Swor et al. and Hoehn-Saric et al. to validate the test taker in order to prevent fraud ('973, column 8, lines 25-55)." Final Rej. 8.

Appellants argue:

[T]he Examiner has not stated that one of ordinary skill would have reasonably expected success in attempting to combine Swor and Hoehn-Saric, much less has the Examiner explained how or why one of ordinary skill would have expected to be able to combine these references. In fact, Swor's health care system is plainly incapable of combination with Hoehn-Saric's test taking system.

Br. 20.

Appellants argue that

[e]ven if Swor and Hoehn-Saric could be combined, which they cannot be, the Examiner has not explained why validating a "test-taker in order to prevent fraud" would have motivated one of ordinary skill in the art to have modified Swor with the disclosure in Hoehn-Saric of presenting a registration card or entering a registration number prior to entering a test kiosk. Preventing fraud in test taking is clearly irrelevant to Swor's health care system.

Br. 20-21.

Appellants argue that neither Swor nor Hoehn-Saric teach or suggest an asset, much less an operator of an asset as recited in the limitation "an input unit operable to receive an operator identifier from an operator of the asset." Br. 19-20.

The Examiner identifies the "asset" as the portable computer in Swor and the kiosk in Hoehn-Saric, and the operator as the user. 2d Ans. 20.

Appellants argue that the rejection should be reversed because the Examiner has failed to address the limitation of "a processing unit . . . operable to prompt . . . a question related to operational status of the asset for the operator." Br. 21. It is argued that Hoehn-Saric teaches at most prompting a question related to a test being taken in a kiosk which is very different from "a question related to operational status of the asset." *Id.*

The Examiner states that the type of question is non-functional descriptive material that does not patentably distinguish the claimed invention from the prior art: "the question does not effect [sic] the operation of the method or more specifically the steps of 'receiving', 'prompting',

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'receiving' and 'storing.'" 2d Ans. 20. The Examiner cites *In re Ngai*, 367 F.3d 1336 (Fed. Cir. 2004).

Issues

Have Appellants shown that the Examiner erred in concluding that the combination of Swor and Hoehn-Saric would have taught or suggested the limitations of "an input unit operable to receive an operator identifier from an operator of the asset" and "a processing unit . . . operable to prompt . . . a question related to operational status of the asset for the operator"?

One issue of claim construction is whether the limitation that the question is "related to operational status of the asset for the operator" is entitled to patentable weight.

Principles of law

Obviousness requires that the combination of references teach or suggest to a person of ordinary skill in the art all of the claim limitations. 35 U.S.C. § 103(a).

When descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability. *In re Ngai*, 367 F.3d 1336, 1339 (Fed. Cir. 2004).

Findings of fact

Swor

Swor describes an interactive system for providing and managing health care data. Col. 1, ll. 7-11.

The system may comprise a terminal 12, called a kiosk, each having a central processor 14, monitor 120, keyboard 121, and modem 125 for communication with a remote facility 50. The system may comprise a substantially portable unit 32, such as a portable computer, handheld processor, or a personal digital assistant. Col. 4, ll. 17-29, 45-58; Figure 1.

One information subsystem includes safety education, which presents the user with a choice between certification courses and tests and continuing education. The tests are done interactively and the answers are routed to a scoring module which displays the test results to the user and transmits them to the central processor. Col. 5, ll. 34-52; Figure 2.

Swor does not describe that the user taking the certification course, tests, or continuing education must identify himself or herself.

Hoehn-Saric

Hoehn-Saric relates to a system for administration of remotely proctored, secure examinations at a remote testing station. Abstract. In its most basic embodiment, the system includes a central station and a remote testing station. Col. 2, ll. 37-59.

The communication between the central station may be by telephone line, ISDN connection, satellite link, or other appropriate data link. Col. 5, ll. 21-23. Thus, Hoehn-Saric discloses a wireless infrastructure.

The test taker must present identification (such as biometric measurements) at the remote test station in order to take the test. Col. 7, l. 35 to col. 8, l. 10. Figure 2, block 40.

Analysis

The appeal as to claim 36, 43, and 44 is dismissed.

Appellants note that Swor does not teach or suggest wireless devices, wireless networks, or wireless communication but do not argue this as a ground for patentability. Br. 19.

The fact that the terminal in Swor can be a handheld processor or personal digital assistant implies wireless devices. In any case, Hoehn-Saric discloses utilizing wireless (e.g., satellite) communication and one of ordinary skill in the art would have been motivated to use any kind of communication in Swor in view of Hoehn-Saric and because wireless systems were a well known alternative to wired systems. Furthermore, as discussed in the § 112 rejection, the independent claims do not recite any steps or functions that rely on the wireless feature of the preamble.

We agree that it would have been obvious to combine Swor and Hoehn-Saric for the reasons stated by the Examiner. The pertinent portions of Swor and Hoehn-Saric relate to test taking and we agree with the Examiner that one of ordinary skill in the art would have been motivated to require a test taker in Swor to provide identification before taking the certification course, test, or continuing education course to prevent fraud in view of the identification teachings of Hoehn-Saric. Preventing fraud in test taking in Hoehn-Saric is relevant to preventing fraud in certification testing and continuing education in Swor. Expectation of success is hardly ever a consideration in mechanical and electrical cases where combination of

features produces predictable results. Appellants have provided no reasons why adding an identification step to Swor would not be expected to work. Accordingly, we are not persuaded by Appellants' arguments that the references cannot be combined or that there is no motivation to combine.

The real issue, however, is not so much whether the references can be combined, but rather whether the proposed combination meets the claimed limitations. We agree with the Examiner that the terminal in Swor is an "asset" and that the person using the terminal to take a test, certification, or continuing education is "an operator of the asset." We also agree that the computer at the remote test site in Hoehn-Saric is an "asset" and that the person using the computer to take a test is "an operator of the asset." "Asset" and "an operator of the asset" are very broad limitations.

The limitation of "a processing unit . . . operable to prompt . . . a question related to operational status of the asset for the operator" is more difficult for the reason stated in the Examiner's Answer, which is that the nature of the question is descriptive matter that is not functionally related to the structure or means. Appellants do not address this reasoning. As a matter of claim interpretation, we conclude that the type of information contained in the question is descriptive matter which is not functionally related to the structure so as to change the structure and therefore the limitation that the question is "related to operational status of the asset for the operator" is not entitled to patentable weight under the principle in *Ngai*. The questions in Swor and Hoehn-Saric could be on any subject without changing the structure. Therefore, the Examiner did not err in concluding

that the combination of references suggests "a processing unit . . . operable to prompt . . . a question related to operational status of the asset for the operator." The considerations may be different for method claims, which involve acts rather than structure, but this issue is not before us since the appeal as to the method claims is dismissed.

Conclusion

As a matter of claim interpretation, the limitation that the question is "related to operational status of the asset for the operator" is not entitled to patentable weight in apparatus claims because it is informational descriptive matter that is not functionally related to, and does not change, the structure.

Appellants have not shown that the Examiner erred in concluding that the combination of Swor and Hoehn-Saric would have taught or suggested the limitations of "an input unit operable to receive an operator identifier from an operator of the asset" and "a processing unit . . . operable to prompt . . . a question related to operational status of the asset for the operator."

For these reasons, the rejection of independent claim 46 is affirmed. Claim 55 recites similar limitations in means-plus-function format and the rejection of claim 55 is likewise affirmed. Appellants do not argue the separate patentability of claims 52, 53, 61, and 62 under the obviousness rejection and accordingly, the rejection of these claims is affirmed.

Claim 37, 47, and 56

The appeal as to claim 37 is dismissed.

The Examiner finds that it was well known that data cannot be successfully communicated from one device to another unless there is a connection between the two. Final Rej. 8-9. The Examiner finds that Swor does not describe where the answers to questions are scored, but that Hoehn-Saric teaches forwarding answers to a central location, and the Examiner concludes that it would have been obvious to transmit the answers if an active communication link exists. *Id.* at 9.

Appellants argue that the Examiner has not cited to support in the record for the assertion that data cannot be communicated unless there is a connection, but even if true, such knowledge "would not have taught or suggested 'determining that an active communication link . . . exists' and if so, 'transmitting the stored response' but 'otherwise, maintaining the response to the question.'" Br. 22.

We do not think that any support is needed for the Examiner's assertion. However, we agree with Appellants that the rejection does not address the specific limitations of the claims. Accordingly, the rejection of claims 47 and 56 is reversed.

Claim 38

The appeal as to claim 38 is dismissed.

Claims 39, 48, and 57

The appeal as to claim 39 is dismissed.

The Examiner takes Official Notice that updating of exam questions, for example, by changing the questions, was well known. Final Rej. 9.

Appellants argue that the Examiner's statement is irrelevant to the claims, which do not recite "updating of exam questions." Br. 23.

Appellants also argue that they seasonably challenged the Examiner's taking of Official Notice and that the Examiner has failed to provide support in the prior art for the Official Notice. *Id.*

Initially, we note that there appears to be no antecedent basis for "the question being stored in said storage unit" in claim 48. It is the "response to the question" that is stored in claim 46.

The Examiner's statement about "updating of exam questions" instead of the claimed limitation "updating the question" is harmless error. It is clear to us, and should be to Appellants, that the Examiner is referring to the combination of Swor and Hoehn-Saric meeting the claim limitation.

We interpret "update the question" in claim 48 and "updating the question" in claim 57 to only require that that question prompted to the operator is changed. Swor and Hoehn-Saric both change the question to the operator and Hoehn-Saric teaches that this may be done over a wireless infrastructure. We do not accept Appellants' contention that the Official Notice in this case must be supported by prior art. Requiring the Examiner to produce a reference without denying that those of ordinary skill in the art were not aware of updating questions or that Appellants have no knowledge that updating questions was well known is not a proper traverse of a taking of Official Notice. Anyone who has ever taken a test knows that the test taker progresses from one question to a new question. Appellants have not

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shown error in the Examiner's rejection. The rejection of claims 48 and 57 is affirmed.

Claims 40-42, 45, 49-51, 54, and 58-60

The appeal as to claims 40-42 and 45 is dismissed.

The Examiner states regarding these claims that "claim language that specifies the type of questions is non-functional descriptive material as the type of questions does not alter how Applicant's process steps are to be performed to achieve the utility of the claimed invention (MPEP 2100-22)." Final Rej. 10.

Appellants argue that the Examiner failed to substantively address the limitations of these claims with respect to the prior art. It is argued that, for example, claim 42 recites "receiving the list of questions via a wireless communications link prior to said storing thereof," which is a clear structural limitation on the method, in addition to any further limitation of claims 42 of "the list of questions being related to OSHA compliance." Br. 24.

Appellants do not contest that the type of information in the questions is not entitled to patentable weight. Thus, the limitations that the question is "specific to the asset" (claims 49 and 58), "related to the operation status of the asset" (claims 50 and 59), "being related to OSHA compliance" (claim 51), and "related to OSHA regulations" (claims 54 and 60) do not patentably distinguish over the questions in Swor and Hoehn-Saric. These claims do not have any other limitations except for storing a list of questions, which is taught in Swor and receiving the questions via a wireless

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communication link which is implied in Swor and taught in Hoehn-Saric.
Accordingly, the rejection of claims 49-51, 54, and 58-60 is affirmed.

CONCLUSION

The appeal as to claims 36-45 is dismissed.

The rejection of claims 46-62 under 35 U.S.C. § 112, second paragraph, is reversed.

The rejection of claims 46, 48-55, and 57-62 under 35 U.S.C. § 103(a) is affirmed.

The rejection of claims 47 and 56 under 35 U.S.C. § 103(a) is reversed.

Requests for extensions of time are governed by 37 C.F.R. § 1.136(b).
See 37 C.F.R. § 41.50(f).

DISMISSED-IN-PART and AFFIRMED-IN-PART

msc

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